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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,771

06/24/2005

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970.1012

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21171 7590 03/06/2009
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EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Amendment

1. Applicant's amendment filed 02/17/2009 has been entered. Due to applicants' amendment claims 1 and 3 are rejected under 35 USC 103(a) as being unpatentable over Otomo (JP 2000-011448) in view of Ota (JP 2000-030302) and claims 2 and 4 are rejected under 35 USC 103(a) as being unpatentable over Otomo (JP 2000-011448) in view of Matsuishi et al. (5,972,457) and Ota (JP 2000-030302) for reasons of record and the reasons set forth below.

The Examiner has set forth the current grounds of rejection above because applicants' amendment has required a change in the grounds of rejection. Applicants are correct in stating that Otomo does not now anticipate claim 1 because of the new limitations regarding "a release layer provided between the substrate and the recording layer;" however, applicants also assert that Otomo in view of Ota do not render obvious the limitations of claims 1 and 3 because the "release layer" is not in the proper location.

The Examiner respectfully disagrees and notes that Ota teach a film for exfoliation **6** that reads on applicants' release layer. This release layer is situated in between the protective layer **5**, which reads on applicants' and Otomo's substrate, and recording layer **3** of the disc of Ota. The Examiner notes that broadest reasonable interpretation of the word "between" does **not** necessarily require that the release layer needs to be directly adjacent (i.e. contacting) the substrate and the recording layer. The Examiner maintains his rejection that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the release layer of Ota

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in between the substrate and recording layer of the medium of Otomo. The results of this combination would have been completely predictable to one having ordinary skill in the art of optical recording media; further, each of the components would perform the same in combination as they did separately. Another motivation for combining these references can be found in Ota at [0021], which discloses that the release provide an extra level of security, wherein the information of the optical disc can be completely destroyed at the time of disposal; further, one of ordinary skill would recognize that this would allow for separation and potential recycling of the individual layers of the optical recording medium.

Applicants argue that their invention does not require "a peeling operation hole" or the need to use "the instrument" to separate the layers.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no need to use "the instrument" or the lack of "a peeling operation hole") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is also noted that applicants use open "comprising" language, and therefore applicants' claims are open to the inclusion of "a peeling operation hole" and use of "the instrument" as seen in Ota.

Applicants argue that the Examiner's motivation to combine is improper because [0021] of Ota does not teach a proper motivation to combine the references.

The Examiner respectfully disagrees and notes that after separation at the layer **6** of Ota, one of ordinary skill would understand that the substrate **5** would be in one stack and the recording layer **3** would be in a separate stack, and therefore Ota does teach a method of separating the substrate and the recording layer; however, it is also noted that applicants' claims are drawn to an article and not a method of using said article. The fact remains that a motivation to use the release layer **6** of Ota to afford separation of the substrate **5** and the recording layer **3** is that the release layer provides an extra level of security, wherein the information of the optical disc can be completely destroyed at the time of disposal; further, one of ordinary skill would recognize that this would allow for separation and potential recycling of the individual layers of the optical recording medium.

Applicants also argue that the combined teachings of Otomo, Matsuishi et al., and Ota do not render obvious applicants' claims 2 and 4.

First, the Examiner does recognize that the combination of Otomo in view of Matsuishi et al. now does not render obvious applicants' claim 2 due to the inclusion of the "release layer provided between the substrate and the printing layer;" however, it is also noted that applicants have not contested that Matsuishi et al. teach a printing layer with a base material layer identical to that claimed, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the printing layer with a base material layer of Matsuishi et al. on the optical recording medium of Otomo. The Examiner maintains that this combination is proper and obvious to one having ordinary skill.

Second, with regard to the inclusion of a “release layer provided between the substrate and the printing layer,” the Examiner maintains that Ota teach a film for exfoliation **6** that reads on applicants’ release layer. It is noted that the Examiner’s original combination would have placed the release layer **6** of Ota in between the substrate and the recording layer; however, the Examiner also made a specific statement regarding the limitations of claim 6, which are the limitations that have been imported into claim 2.

The Examiner contends that the inclusion of a release layer in between any two layers in the optical recording medium of Otomo would be *prima facie* obvious because the inclusion of multiple release layers is a mere duplication of parts. It has been held that “mere duplication of parts has no patentable significance unless a new and unexpected result is produced.” Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). It would have been obvious to one having ordinary skill in the art of optical recording media to include a release layer at any position in the optical recording medium strata, including in between the printing layer and the substrate as claimed. A motivation for doing so would be additional security as it would allow one to dispose of the printing layer, which might have important information thereon, or for affording separation and potential recycling of the individual layers of the optical recording medium.

Applicants argue that “[o]ne of ordinary skill in the art would not have been prompted by the combined teachings of Otomo, Matsuishi, and Ota to arrive at the invention of amended claims 2.”

The Examiner respectfully disagrees and notes that the Supreme Court in *KSR v. Teleflex* 550 U.S. 398 (2007) stated that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claims, [one] can take into account of the inferences and creative steps that a person of ordinary skill in the art would employ;” further, the court stated that “[a] person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.” The Examiner maintains that it would have been obvious to include a release layer at any point in the stack of layers of the recording medium of Otomo in view of Matsuishi et al. A motivation for doing so would be additional security as it would allow one to dispose of the printing layer, which might have important information thereon, or for affording separation and potential recycling of the individual layers of the optical recording medium.

In conclusion, the Examiner maintains that the crucial elements of claims 1 and 2 that applicants have argued (i.e. the release layer) are rendered obvious by the teachings of Ota; furthermore, the claims as a whole are rendered obvious by the combined teachings of Otomo, Matsuishi et al., and Ota. The claims remain finally rejected.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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